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EXAMINER	
SMITH, JENNIFER A	
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLEG STENZEL, STEFAN UHRLANDT, HANS-DETLEF LUGINSLAND, and ANDRE WEHMEIER

Appeal 2010-000024
Application 10/522,672
Technology Center 1700

Decided: April 12, 2010

Before EDWARD C. KIMLIN, PETER F. KRATZ, and MARK NAGUMO, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-4 and 20. Claims 5-15, 17 and 19 stand withdrawn from consideration. Claim 1 is illustrative:

1. A precipitated silica which has the following properties:

BET surface area 200 - 300 m^2/g,

CTAB surface area	≥ 170 m^2/g,
DBP number	200 - 300 g/(100 g), and
Sears number V_2	23-35 ml/(5 g).

The Examiner relies upon the following reference as evidence of obviousness:

Uhrlandt	6,180,076 B1	Jan. 30, 2001

Appellants' claimed invention is directed to a precipitated silica having the recited properties.

Appealed claims 1-4 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Uhrlandt.[1]

We have thoroughly reviewed the respective positions advanced by Appellants and the Examiner. In so doing, we will not sustain the Examiner's rejection.

As acknowledged by Appellants, Uhrlandt discloses a precipitated silica having ranges of values for BET surface area, CTAB surface area, DBP number, and Sears number V_2 which overlap the claimed ranges. Although the exemplified silicas of Uhrlandt do not possess properties having values that fall within all four of the recited ranges, we do not agree with Appellants that the appealed claims are "only a very small and narrow part" of the referenced disclosure such that silicas within the scope of the appealed claims are not prima facie obvious.

However, the Examiner has committed reversible error by not properly evaluating Appellants' Declaration evidence and weighing its probative value against the evidence of obviousness. Appellants'

[1] We presume the omission of claim 20 from the statement of the rejection at page 3 of the Answer is an oversight.

Declaration provides a comparison between an exemplified silica of Uhrlandt and an example representative of the claimed silica. According to the Declarant, the higher CTAB values of the inventive precipitated silica lead to reduced attrition while maintaining a rolling resistance of the tire comprising the silica. In the words of the Declarant, "[t]his effect was unexpected, because one of skill in the art would expect that upon an increase in the CTAB values, an increase in rolling resistance would be observed" (Dec. ¶5).

The Examiner errs in evaluating the declaration by stating that "the claims are drawn to a silica, not to tires" (Ans. 6, last para.). Appellants properly state that "the properties of dynamic modulus and rigidity of tires prepared from the present precipitated silica are disclosed properties, as described in the specification at page 32, lines 8-11, which properties therefore can be relied upon in evaluating the difference between the precipitated silica as claimed and that of Uhrlandt et al." (Prin. Br. 7, first full para.).

The Examiner further errs in stating that the reference examples "cannot be compared to the instant invention in any way because none of the examples of Uhrlandt et al. have all the parameters within the instantly claimed ranges" (Ans. 7, last para.). However, such a requirement would preclude an Applicant from rebutting a prima facie case of obviousness with unexpected results for a claimed sub-genus that falls within a broader genus of the prior art. As set forth by Appellants, "[t]he Examiner's rationale appears to be that Appellants should have compared the present invention to the present invention!" (Reply Br. 3, third full para.). Manifestly, such a requirement is improper.

In conclusion, based on the foregoing, we are constrained to reverse the Examiner's rejection.

REVERSED

kmm

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